

Application No. 10/825,522  
Amendment dated November 12, 2009  
Reply to Final Office Action of September 1, 2009

### **REMARKS**

Applicant amended independent claims 1, 6, and 11 and added new claims 16-18 to further define Applicant's claimed invention. Support for the amendments to independent claims 1, 6, and 11 and for new claims 16-18 can be found in the specification at least on page 9, lines 26-30 and in FIGS. 5 and 7. No new matter has been added.

In the Office Action, the Examiner rejected claims 1-15 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully disagrees with the Examiner's contention that the "newly claimed range with the lower limit 'one-half the length of the implant' . . . is not supported in the original disclosure." (Office Action, page 2, lines 10-11). Applicant submits that FIGS. 5 and 7 of application serial No. 09/566,272, to which Applicant claims priority and which is incorporated by reference in this application, fully support the recitation objected to by the Examiner. Nonetheless, Applicant amended independent claims 1, 6, and 11 to recite "the opening of the medial side extending along a majority of the length of the implant" to further advance the prosecution of this application.

The MPEP states that "[a]n applicant may show possession of an invention by disclosure of drawings . . . that are sufficiently detailed to show that applicant was in possession of the claimed invention as a whole. See, e.g., *Vas-Cath*, 935 F.2d at 1565, 19 USPQ2d at 1118 ('drawings alone may provide a 'written description' of an invention as required by Sec. 112\*')." (MPEP § 2163, paragraph bridging pp. 2100-178 and 179, Rev. 6, 2007). Applicant submits that at least FIGS. 5 and 7 as originally filed are sufficiently detailed to show that Applicant was in possession of the invention claimed in independent claims 1, 6, and 11, as amended. Accordingly, it is submitted that the Examiner's rejection of claims 1-15 under 35 U.S.C. § 112, first paragraph, has been overcome.

The Examiner rejected claims 1-15 under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 5,645,598 to Brosnahan ("Brosnahan") and U.S. Patent No. 5,593,409 to Michelson ("Michelson '409"), further in view of U.S. Patent No. 4,834,757 to Brantigan ("Brantigan '757") or U.S. Patent No. 5,192,327 to Brantigan ("Brantigan '327"). Independent claims 1, 6, and 11, as now amended, each recite a method including providing a first implant having a medial side

Application No. 10/826,522  
Amendment dated November 12, 2009  
Reply to Final Office Action of September 1, 2009

with at least one opening in communication with the hollow interior, the opening of the medial side extending along a majority of the length of the implant, and "introducing osteogenic material through the opening of the medial side" of the first implant. None of Brosnahan, Michelson '409, Brantigan '757, and Brantigan '327, whether alone or in proper combination, teaches or suggests a method as recited in each of independent claims 1, 6, and 11. Applicant submits that the Examiner's rejection of claims 1-15 under 35 U.S.C. § 103(a) over Brosnahan and Michelson '409 in view of Brantigan '327, or Brantigan '757 has been overcome.

Applicant submits that independent claims 1, 6, and 11 are patentable and that dependent claims 2-5, 7-10, and 12-18 dependent from one of independent claims 1, 6, and 11, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-3726.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: November 12, 2009

By: 

Amedeo F. Ferraro  
Registration No. 37,129

1557 Lake O'Pines Street, NE  
Hartville, Ohio 44632  
Telephone: (310) 286-9800  
Facsimile: (310) 286-2795